



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,088	05/01/2001	Y. Tom Tang	PF-0622 USN	8378

7590

12/03/2002

Incyte Genomics Inc
Legal Department
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER

HUTSON, RICHARD G

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 12/03/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,088

Applicant(s)

TANG ET AL.

Examiner

Richard G Hutson

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, and 15, drawn to a polypeptide comprising an amino acid sequence selected from the group consisting of SEQ ID NO: 1-5 and fragments thereof.

Group II, claim(s) 3-6, 9-11, 12-14, drawn to a polynucleotide encoding the polypeptide of claim 1 and vectors and host cells expressing said polynucleotide and methods of expressing said polynucleotide.

Group III, claim(s) 7 and 8, drawn to a method for detecting a polynucleotide.

Group IV, claim(s) 16, drawn to antibody which specifically binds the polypeptide of claim 1.

Group V, claim(s) 17, drawn to an agonist of the polypeptide of claim 1.

Group VI, claim(s) 18, drawn to an antagonist of the polypeptide of claim 1.

Group VII, claim(s) 19, drawn to a method for treating a disorder associated with decreased expression of a CoA enzyme comprising administering the polypeptide of claim 1.

Group VIII, claim(s) 20, drawn to a method for treating a disorder associated with decreased expression of a CoA enzyme comprising administering the antagonist of claim 18.

For each of inventions I-VIII above, restriction to one of the following is also required under 35 USC 121. Therefore, election is required of one of inventions I-VIII and one of inventions (A)-(E).

Art Unit: 1652

- (A). SEQ ID NO: 6 or a sequence encoding SEQ ID NO: 1.
- (B). SEQ ID NO: 7 or a sequence encoding SEQ ID NO: 2.
- (C). SEQ ID NO: 8 or a sequence encoding SEQ ID NO: 3.
- (D). SEQ ID NO: 9 or a sequence encoding SEQ ID NO: 4.
- (E). SEQ ID NO: 10 or a sequence encoding SEQ ID NO: 5.

The inventions listed as Groups I through VIII and (A) through (E) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I through VIII share a technical relationship which corresponds to a polypeptide comprising an amino acid sequence selected from the group consisting of SEQ ID NO: 1-5 and fragments thereof. Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. West et al. (DNA and Cell Biology, Vol. 16, No. 6, 1997, pages 691-701, see applicants international search report) teach the cloning and expression of two human lysophosphatidic acid acyltransferases cDNAs and the taught polypeptides each comprise an amino acid sequence of a fragment of SEQ ID NOs 1-5. A fragment of SEQ ID NOs 1-5 being as small as a single amino acid such as alanine or glutamine. Since the shared technical

feature of each of the groups is not a "special technical feature", unity of invention between the groups does not exist.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 09/831,088

Page 5

Art Unit: 1652

A handwritten signature in black ink, appearing to read "Richard Hutson", with a long horizontal flourish extending to the right.

Richard Hutson, Ph.D.

Patent Examiner

Art Unit 1652

December 2, 2002